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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/712,935	11/12/2003	Mark M. Kotik	PREDYN-44227	9890
26252 7590 05/15/2007 KELLY LOWRY & KELLEY, LLP 6320 CANOGA AVENUE SUITE 1650 WOODLAND HILLS, CA 91367			EXAMINER NGUYEN, KIMBERLY D	
			ART UNIT 2876	PAPER NUMBER
			MAIL DATE 05/15/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

Application No.

10/712,935

Applicant(s)

KOTIK ET AL.

Examiner

Kimberly D. Nguyen

Art Unit

2876

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 01 March 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-9, 11-26, 28-43 and 45-55 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9, 11-26, 28-43 and 45-55 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### DETAILED ACTION

1. Acknowledgment is made of Amendment filed March 1, 2007.

#### ***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-9, 11-22, 24-26, 28-43, and 45-55 are rejected under 35 U.S.C. 103(a) as being unpatentable over De La Huerga (US 2002/0084904 A1).

Re claims 1-3, 5, 11, 15, 17-21, 30, 32-35, 37-42, 45-47, and 50-55: De La Huerga teaches an identification band (figs. 1-2), including:

an elongated flexible strap (bracelet 104) having a head end and a tail end (first and second ends 106 and 108 in fig. 2; paragraph 103);

a communication circuit (figs. 3-5) carried by the strap (paragraphs 38, 107), the communication circuit including a pair of electronic coupling elements (1311, 1313 in fig. 17) disposed generally at the strap head and tail ends (paragraphs 161, 103); and

an adhesive for securing the strap head and tail ends (106, 108 in fig. 2; capacitive plates 358, 360 in fig. 34) in overlapping relation with the pair of electronic coupling elements in mutually coupled relation, to configure the strap into a closed loop shape of selected circumferential size ("...the ends may be secured via adhesive, melting, crimping, etc"; paragraph 103) ("...the glue strips 1319 secure the ends together..." paragraphs 162, 193-195);

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wherein one of said coupling elements (106, 108 in fig. 2; capacitive plates 358, 360 in fig. 34; 1317, 1315 in fig. 17) has a predetermined area as shown in fig. 17 (paragraphs 161-162);

at least one of the electronic coupling elements being physically altered in response to attempted forced separation of the adhesively secured strap head and tail ends to correspondingly alter at least one characteristic of the communication circuit ("...the strap cannot be broken or cut without opening the short circuit..." paragraph 50) ("...If the strap is no longer attached to the patient one of several different functions occur, the several different functions including: erasing the memory, prohibiting reprogramming and access to the memory..." paragraph 59), ("The memory device is integrally embedded in the strap and cannot be removed from the strap without destroying the device." paragraph 38) (paragraphs 38, 51-61, 103-117, 149, 162 and 179-181).

As shown in figures 34 and 35, the capacitive plates 358, 360 are overlap each other and have a predetermined length (paragraphs 228-229).

However, De La Huerga does not specifically teach wherein the other of said coupling elements has a length greater than the length of said one coupling element.

It would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to integrate/modify the capacitor plates with a predetermined length as taught by De La Huerga in order to come up with the capacitor/coupling plate has a length greater than the length of the other capacitor/coupling plate as set forth in the

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claimed invention. Furthermore, changes in size/shape is not patentably distinct from the prior art device (See MPEP 2144.04 IV).

*In re Rose*, 220 F.2d 459, 105 USPQ 237 (CCPA 1955) (Claims directed to a lumber package "of appreciable size and weight requiring handling by a lift truck" where held unpatentable over prior art lumber packages which could be lifted by hand because limitations relating to the size of the package were not sufficient to patentably distinguish over the prior art.); *In re Rinehart*, 531 F.2d 1048, 189 USPQ 143 (CCPA 1976) ("mere scaling up of a prior art process capable of being scaled up, if such were the case, would not establish patentability in a claim to an old process so scaled." 531 F.2d at 1053, 189 USPQ at 148.).

In *Gardner v. TEC Systems, Inc.*, 725 F.2d 1338, 220 USPQ 777 (Fed. Cir. 1984), *cert. denied*, 469 U.S. 830, 225 USPQ 232 (1984), the Federal Circuit held that, where the only difference between the prior art and the claims was a recitation of relative dimensions of the claimed device and a device having the claimed relative dimensions

would not perform differently than the prior art device, the claimed device was not patentably distinct from the prior art device.

Re claims 4, 22, and 36: De La Huerga teaches the bracelet (104) is formed of a tear resistant plastic material, which is a dielectric material.

Re claims 6: De La Huerga teaches "...the surfaces 1325 and 1112 are pressed together so that the glue strips 1319 secure ends together..." (paragraphs 162, 228-229), which is the glue strip is a pressure sensitive adhesive.

Re claims 7 and 12-13: De La Huerga teaches, for example, "the plates 358 and 360 overlay and are separated by a thin layer of plastic band material there between..." (paragraphs 228-229), wherein the thin layer serves as a protective film mounted over at least a portion of the communication circuit.

Re claims 8 and 24: De La Huerga teaches the identification device (fig. 15) having a transmitter, an RF antenna, etc, to communicate with a remote reader (300 in fig. 6) (paragraph 223).

Re claims 9, 14, 16, 26, 29, 31, and 43: De La Huerga teaches "...when ends 354 and 356 are secured (e.g., glued via an adhesive) together, plates 358 and 360 are close enough to form a capacitive coupling such that a complete loop is formed by the device components including the capacitive coupling between plates 358 and 360..." (paragraphs 228-229 and 161-164, figs. 34-35), wherein the capacitive coupling plates 358 and 360 serve as a pair of capacitor plates.

Re claim 25: De La Huerga teaches the electronic coupling elements comprising conductive films printed onto the flexible strap (see 116 in fig. 2).

Re claims 48-49: De La Huerga teaches wherein the pair of capacitor plates (L2/1315 and L1/1317 in fig. 17; 358 and 360 in fig. 34) are electrically connected by conductive traces (1311, 1313 as shown in fig. 17) carried by the strap (paragraphs 161-163, 228-229).

4. Claim 23 is rejected under 35 U.S.C. 103(a) as being unpatentable over De La Huerga in view of Harilela (US 4,862,436). The teachings of De La Huerga have been discussed above.

De La Huerga fails to specifically teach or fairly suggest a peel-off strip protectively covering the patch.

Harilela teaches a strap (14) having pads (10, 11) for fastening the strap to a wearer's wrist, wherein each pad (10, 11) has an adhesive backing with a peel-off protection layer 20 (figs. 4-5; col. 2, lines 38-55).

It would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to incorporate the well-known adhesive backing with a peel-off protection layer as taught by Harilela to the teachings of De La Huerga due to the fact that one does not have to retreat a glue and/or adhesive means to secure the two ends of the wrist strap as taught by De La Huerga but rather peel off the protection layer and secure the two ends of the wrist strap as pre-made by the manufacturer. Furthermore, De La Huerga teaches the means (e.g., glue or an adhesive to secure the two ends of the wrist strap), therefore, one of ordinary skill in the art would have recognized the necessity to employ the peel-off protection layer to protect the adhesive/glue layer from being damaged by the dust, scratches, or being dried-up, etc.

### ***Response to Arguments***

Applicant's arguments, see pages 11+, filed March 1, 2007, with respect to the rejection(s) of claim(s) under U.S.C. 102(b) anticipated by De La Huerga have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of De La Huerga under U.S.C. 103(a) as set forth above.

### ***Conclusion***

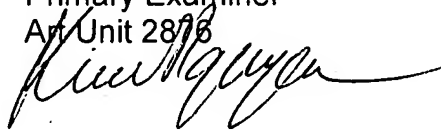
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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kimberly D. Nguyen whose telephone number is 571-272-2402. The examiner can normally be reached on 8 - 5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee can be reached on 571-272-2402. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Kimberly D Nguyen  
Primary Examiner  
Art Unit 2876



kdn